

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Song
 Serial No.: 10/770,893
 Filed: February 3, 2004
 Group Art Unit: 1793
 Examiner: Christopher S. Kessler
 Title: CASTABLE HIGH TEMPERATURE ALUMINUM ALLOY

Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

APPEAL BRIEF

Dear Sir:

Appellant now submits this Appeal Brief subsequent to the filing of the Notice of Appeal. Fees in the amount of \$540.00 may be charged to Deposit Account Number 21-0279 in the name of United Technologies Corporation.

Additionally, the PTO apparently issued a Notice of Panel Decision on July 30, 2009 from Appellant's Pre-Appeal Brief Review. Appellant did not receive this Notice but desires to continue this application and appeal. Examiner Kessler called Appellant's representative on March 2, 2010. Examiner Kessler has either not abandoned this case or has withdrawn the apparent abandonment due to Appellant's non-receipt of the Notice. Applicant believes that fees in the amount of \$2350.00 for a 5 month extension are necessary; however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

In the alternative that this application is considered to be abandoned, this paper should be considered a Petition to Revive an unintentionally abandoned application under 37 CFR 1.137(b) and the fee in the amount of \$1620 may be charged to the Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition was unintentional.

Adjustment date: 08/16/2010 CKHLOK
 03/05/2010 INTEFSW 00000137 501482 10770893
 01 FC:1255 2350.00 CR

The fact that a certain result or characteristic may occur or be present is not sufficient to establish the inherency. To establish inherency, the evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The Examiner must show more than a probability or mere possibility, i.e., the Examiner must show that the claimed elements are inevitably or invariably always in aluminum alloys. See MPEP 2112 IV.

The "ASM Specialty Handbook, Properties of Pure Aluminum" that the Examiner points to merely lists possible impurity elements and does not explicitly state that all the listed elements would be necessarily be present in an aluminum alloy. Further, since the elements are impurities, one could not pick and choose which elements are present. Accordingly, the rejection is improper and must be reversed.

IV. Rejection of claims 5 and 6 under 35 U.S.C. §103(a) over Watson in view of Higashi.

As pointed out above under section I, the Watson reference does not suggest that erbium, ytterbium and scandium are equivalents that could be freely substituted for one another. Therefore, adding the teachings of Higashi does not resolve the noted issues with regard to Watson and the rejection must be reversed.

Closing

For the reasons set forth above, the final rejection of claims 1-16 and 26-29 is improper and must be reversed.

Respectfully submitted,

/Matthew L. Koziarz/

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Dated: March 5, 2010

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND

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